

REMARKS

The Office Action dated April 4, 2005, has been received and carefully considered. In this response, claims 1 and 5 have been amended. Entry of the amendments to the claims is respectfully requested. Reconsideration of the outstanding rejections in the present application is also respectfully requested based on the following remarks.

THE ANTICIPATION REJECTION OF CLAIMS 1, 3, 4, 5, 7 and 8-12

On pages 2-3 of the Office Action, claims 1, 3, 4, 5, 7 and 8-12 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Foster. This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. In re Sun, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. Id. “In addition, the prior art reference must be enabling.” Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. In re Donohue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985). “Such possession is effected if one of ordinary skill in the art could have combined the publication’s description of the invention with his own knowledge to make the claimed invention.” Id.

The Examiner asserts that Foster discloses delivering stored consumer data by delivery of a message to the vendor containing the cardholder's shipping address. However, Foster does not disclose or suggest delivering to the vendor "stored consumer data ... wherein receipt of the stored consumer data by the vendor enables the vendor to receive payment for the E-commerce transaction" as recited in amended claims 1 and 5. Indeed, it would be counter to the purpose of Foster to do so, as Foster employs card center 202 to complete payment.

Foster discloses a markedly different arrangement for payment. As disclosed in Fig. 7 and the accompanying portion of the Description of Specific Embodiments, Foster's method requires that the merchant send a purchase order to the cardholder (indicated at 708). Then, the cardholder sends the request to pay to the card company, which checks to see if payment can be completed. See, col. 11, lines 27-53. If payment can be completed, the card company completes the payment and notifies the merchant as indicated at 720. Therefore, Foster does not disclose or suggest delivering to the vendor "stored consumer data ... wherein receipt of the stored consumer data by the vendor enables the vendor to receive payment for the E-commerce transaction" as recited in amended claims 1 and 5. For at least this reason, Applicants respectfully submit that the rejections of claims 1 and 5 are improper.

Claims 3, 4, 7 and 8-12 are dependent upon one of independent claims 1 and 5. Thus, since independent claims 1 and 5 should be allowable as discussed above, claims 3, 4, 7 and 8-12 should also be allowable at least by virtue of their dependency on one of independent claims 1 and 5. Moreover, these claims recite additional

features which are not claimed, disclosed, or even suggested by the cited references taken either alone or in combination.

In view of the foregoing, it is respectfully requested that the aforementioned anticipation rejection of claims 1, 3, 4, 5, 7 and 8-12 be withdrawn.

THE OBVIOUSNESS REJECTION OF CLAIMS 2 and 6

On pages 3-4 of the Office Action, claims 2 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Foster in view of Weber, et al. ("Weber"). This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a prima facie case of obviousness. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Patent Office can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of references. Id. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). That is, under 35 U.S.C. § 103, teachings of references can be combined only if there is some suggestion or motivation to do so. Id. However, the motivation cannot come from the applicant's invention itself. In re Oetiker, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992). Rather, there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the art would make the combination. Id.

As stated in MPEP § 2143, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Also, as stated in MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Further, as stated in MPEP § 2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). That is, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). Additionally, as stated in MPEP § 2141.02, a prior art reference must be considered in its entirety, i.e., as a

whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Finally, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

The Examiner relies on Weber to disclose a virtual private network and, as such, Weber fails to cure the above noted deficiencies of Foster with respect to claims 1 and 5. Therefore, the combination of Foster and Weber also fails to disclose each feature recited in claims 2 and 6. Applicants respectfully submit that the rejections are improper for at least this reason.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 2 and 6 be withdrawn.

X. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.


To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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